

Notice of Allowability

Application No.

09/892,872

Examiner

B. William Baumeister

Applicant(s)

SHIMODA ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Appeal Brief filed 7/27/04.
2. ☒ The allowed claim(s) is/are 1-25.
3. ☒ The drawings filed on 29 May 2003 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

Election/Restrictions

1. Claims 1 and 12 are generic and allowable. Accordingly, the restriction requirement as to the encompassed combination inventions is hereby withdrawn and claims 7, 11 and 17, directed to the combinations of inventions V and VI are no longer withdrawn from consideration since all of the claims to this combination depend from or otherwise include each of the limitations of an allowed generic claim.

2. In view of the above noted withdrawal of the restriction requirement as to the linked inventions, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Allowable Subject Matter

3. Claims 1-25 are allowed.

4. The following is an examiner's statement of reasons for allowance:

a. Applicant has admitted that the integration of passive matrix arrays (PMAs) and peripheral circuitry was known (see e.g., FIG 26 and the background section of the specification). Also Smith teaches self-assembling microstructures as was explained throughout prosecution. The only issue remaining was whether motivation existed to

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employ self-assembly microstructure technology (such as taught by Smith) in a manner such that at least one of the PMAs and peripheral circuits are formed on a microstructure.

b. The examiner's position throughout prosecution has been that Applicant's BACKGROUND section of the specification included the admission that it was conventionally known that the integration of the PMAs and peripheral circuits posed processing problems that led to the deterioration of both components, and that the conventional process of making the device of FIG 26 required an intentional limiting of the growth-process conditions so that the compromise between the respective structural deteriorations, that result from the various conflicting processing requirements, could be adequately balanced. (See paragraphs 9-11 of the specification.)

c. Applicants now assert for the first time in the Appeal Brief that the Examiner's interpretation of the specification's paragraphs 9-11 was incorrect: Applicant's intended interpretation was that "[p]aragraphs [0009] – [0011] disclose the Applicants' observed problems with the conventional formation of the passive matrix array. These disadvantages of the conventional formation of passive matrix array were observed by Applicants. Applicants' comments regarding the disadvantages of the conventional formation of passive matrix array are not themselves prior art." (Appeal Brief, page 9, last full paragraph.)

d. The claims are therefore allowable based solely upon Applicants' explanation that their statements in the specification relating to the prior art were not an admission that the drawbacks or limitations—associated with the prior-art method for integrating PMAs and peripheral circuits—were also known by others. Absent any evidence that others timely

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knew that the prior-art structure possessed any such associated problems or limitations resulting from the integration of the PMAs and peripheral circuits, motivation sufficient for combining the admitted PMA prior art with the self-assembling-microstructure technology prior-art, and therefore sufficient to establish a *prima facie* case of obviousness, does not exist.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. William Baumeister whose telephone number is (571) 272-1722. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Thomas can be reached on (571) 272-1664. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**BRADLEY BAUMEISTER
PRIMARY EXAMINER**



B. William Baumeister
Primary Examiner
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August 25, 2004